

## RESPONSE

1. Priority under 35 U.S.C. § 119

Applicants note that the Examiner failed to acknowledge receipt of a certified copy of the priority document (PCT/EP99/03107, filed May 6, 1999) that forms the basis of the claim for priority in this application. Applicants respectfully request the Examiner to acknowledge receipt of the foreign priority document submitted under 35 U.S.C. § 119 with the original application papers. If the document has been lost, a new document will be provided.

2. Acknowledgment of Prior Art

Applicants note that the Examiner did not indicate by a statement in the first Official Action that the documents cited in the International Search Report were considered by the Examiner in accordance with M.P.E.P. § 609. Applicants hereby request an acknowledgment of the documents cited in the International Search Report in the next Action. If the documents have been lost or are not present in the file, new copies of the documents will be provided.

3. Rejection of claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,212,372 (Julin) in view of U.S. Patent 5,956,653 (Lahti)

The Examiner has rejected claims 1-16 as being unpatentable over Julin in view of Lahti. For the reasons put forth below, Applicants respectfully traverse this rejection and assert that independent claims 1, 2, 6, 13 and 14 are presently patentable over Julin and Lahti, whether considered collectively or independently. Further, claims 3-5, which directly depend from claim 1, claims 7-12, which depend directly or indirectly from claim 6, and claims 15-16, which depend directly from claim 13, are also patentable over Julin and Lahti based in significant part on their individual structural elements and the general distinction of claims 1, 2, 6, 13 and 14 therefrom enumerated below.

a. Invention Distinguished

The present invention relates to a mobile radio system having a plurality of mobile terminals (ME) connected with a mobile switching center (MZ) via an air interface for communication control and optionally for billing. The mobile terminals (ME) are controlled by a subscriber identity module (SIM) in which data for associating at least one user are stored. The subscriber identity module (SIM) has an identity (IMSI) associated therewith. The subscriber identity module (SIM) includes a calculation rule for calculating and generating from the stored identity (IMSI) at least one further identity (IMSI<sub>w</sub>). The identities generated by the calculation rule are associated accordingly in the mobile switching center.

b. References Distinguished

Although Julin and Lahti each disclose a mobile telephone system using a subscriber identity module, each of these references fail to disclose or suggest a mobile telephone system including a subscriber identity module including a calculation rule for generating and calculating from the stored identity (IMSI) at least one further identity (IMSI<sub>w</sub>).

In the Official Action, the Examiner correctly indicates that Julin fails to disclose or suggest a subscriber identity module that includes a calculation rule for generating and calculating from the stored identity an additional identity. Specifically, Julin describes a method in mobile telephone systems in which a subscriber identity module is allocated at least two predetermined identities which are selectively activated by the user. Applicants submit that a subscriber identity module being allocated with at least two predetermined identities is distinguishable from a subscriber identity module having a calculation rule which calculates and generates additional identities from a single stored identity. As a result, Julin fails to disclose or suggest the subscriber identity module having the calculation rule of the present invention.

Lahti fails to make up for the shortcomings of Julin, namely Lahti fails to disclose or suggest the subscriber identity module having a calculation rule of the present invention. The Examiner maintains that Lahti describes the calculation rule of the present invention. Applicants respectfully traverse this assertion.

Lahti is directed to a method in which a mobile telephone subscriber can operate between two different, predetermined stored identities (IMSI1 and IMSI2). In order to operate between the two different stored identities, an adapter is used to deactivate IMSI2 and activate IMSI1 stored on the adapter. When the adapter is removed, the IMSI2 is reactivated (col. 2, lines 7-27). Use of the adapter thus permits calls to be separated from one another using one of the different predetermined identities (IMSI1 and IMSI2) with the adapter and therefore being priced at different rates depending on whether the adapter is being used or not.

Applicants submit that the adapter of Lahti cannot be construed as a subscriber identity module (SIM) having a calculation rule for calculating and generating from the stored identity (IMSI) at least one further identity (IMSI<sub>w</sub>) as recited in the present invention. First, the present invention does not require an adapter to operate between different identities. By providing a subscriber identity module having a calculation rule, there is no need for a device having one identity to deactivate another identity when used in the mobile system. Second, in the present invention the subscriber identity module, itself, is able to generate from a single IMSI and subsequently store, different identities. In Lahti, both IMSI1 and IMSI2 are predetermined and are therefore not generated from a single IMSI.

*1/2*

Therefore, there is no disclosure or suggestion in Lahti as to how new identities (IMSI<sub>w</sub>) are generated from and stored from a single known IMSI. Furthermore, there is no disclosure or suggestion, while asserted by the Examiner, of a calculation rule as recited in the present invention.

In view of these observations, Applicants submit that Julin and Lahti, whether considered independently or collectively, fail to disclose or suggest the basic claimed invention of claims 1, 2, 6, 13 and 14 . As a result, claims 3-5, 7-12 and 15-16 are equally patentable in view of their dependency on the independent claims and their individual structural elements. Accordingly, withdrawal of the rejection is requested.

4. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that claims 1-15 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicants' Attorney, the Examiner is invited to contact the undersigned at the numbers shown below.

Respectfully submitted,  
BACON & THOMAS, PLLC



JUSTIN J. CASSELL  
Attorney for Applicants  
Registration No. 46,205

BACON & THOMAS, PLLC  
625 Slaters Lane - 4th Floor  
Alexandria, VA 22314-1176  
Telephone: (703) 683-0500  
Facsimile: (703) 683-1080

Date: August 20, 2002



## APPENDIX OF MARKED-UP SPECIFICATION

Page 1, after the title of the invention and before the beginning of the first paragraph, please insert the following title:

--BACKGROUND OF THE INVENTION--.

Page 1, lines 1-6 (first paragraph), please amend as follows:

--This invention relates to a mobile radio system having a plurality of mobile terminals connected with a mobile switching center via an air interface for communication control and optionally for billing[, as stated in the preamble of claim 1 or claim 2]. In addition the invention relates to a method for operating mobile terminals of a mobile radio system [according to the preamble of claim 6], and to a subscriber identity module for a mobile terminal [according to the preamble of claim 13].--

Page 2, lines 4-8, delete these paragraphs in their entirety.

Page 2, between lines 8 and 9 (before the beginning of the 4<sup>th</sup> paragraph), please insert the following title:

--SUMMARY OF THE INVENTION--.

Page 2, lines 9-23 (4<sup>th</sup> and 5<sup>th</sup> paragraphs), please amend these paragraphs as follows:

--[According to claim 1 a] A mobile radio system is provided wherein the subscriber identity module used for controlling the mobile terminals contains a calculation rule for calculating at least one further identity from the stored identity. Identities generated in accordance with the calculation rule are associated accordingly in the mobile switching center. An alternative for solving the abovementioned problem [according to claim 2] is to design the subscriber identify module so as to permit generation of a request signal which is transmitted to the mobile switching center and

processed there, whereupon an alternative identity is communicated to the subscriber identity module via the air interface.

The advantage of the [solutions according to claims 1 and 2] present invention is that one need not store all identities on the chip card, i.e., the subscriber identity module. This makes the system more flexible to handle since the additional identities can be assigned after the card is issued to the user, i.e. after he has applied for the connection. It is thus possible for the owner of a mobile phone having an associated identity to obtain a second identity at a later time without a new card having to be issued.--

Page 4, between lines 11 and 12 (before the beginning of the 3<sup>rd</sup> paragraph), please insert the following title:

--BRIEF DESCRIPTION OF THE DRAWINGS--.

Page 4, between lines 18 and 19 (before the beginning of the last paragraph), please insert the following title:

--DETAILED DESCRIPTION OF THE INVENTION--.